

REMARKS

This Amendment, submitted in response to the Office Action dated January 31, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-99 are all the claims pending in the application.

I. Rejection of claims 1, 30, 31, 60, 61 and 90 under 112, first paragraph

Claims 1, 30, 31, 60, 61 and 90 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that the step of “storing said custom content object in said one or more object servers; and storing information specifying the custom content object and the attribute information in the library server” is not described in the specification.

Claims 1, 30, 31, 60, 61 and 90 have been amended to further clarify the language of the claims in response the § 112, first paragraph. Consequently, Applicant respectfully requests that the amendments to the claims be entered.

As previously submitted, “storing said custom content object in said one ore more object servers” is described at, for example, page 8, lines 14-19 and page 9, lines 7-11 of the specification. See also, Fig. 3, object server 48. These portions of the written description describe the Digital Library 20, shown in Fig. 1 for example, and shown in more detail in Fig. 3. Further, the specification describes an example of a custom content outline that is called a custom book outline (CBO). See page 54, lines 13-15 (“In the current example for creating custom textbooks, the CCO is called a custom book outline or CBO.”) A CBO is stored in the digital library as a part. See pg. 55, line 21 (“CBO according to the present example is stored as

a digital library part.”) In the digital library described in the specification, “parts” are stored in the digital library’s object servers. See page 10, lines 16-18 (“The object server 48 uses object server table 64 to manage storage of parts in its storage areas, such as the object store 50.”) Accordingly, the specification describes storing a custom content object (e.g., a CBO) in a digital library object server.

The specification also describes an Attribute file “ATR” that contains information about the CBO that is stored in the digital library’s library server. See page 39, lines 3-4 (“All Attribute Files are parsed and the resultant parametric data is stored in the digital library server 44.”)

Therefore, Applicant submits that the claim recitations are disclosed in the specification. Consequently, the 112, first paragraph rejection of claims 1, 30, 31, 60, 61 and 90 should be withdrawn.

II. Rejection of claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 under 103(a) as being unpatentable over McGraw in view of Santamaki

Claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over The McGraw-Hill Companies [McGraw Hill Primis Custom Publishing; hereinafter “McGraw”] in view of Santamaki et al. [USP 6,886,036 B1; hereinafter “Santamaki”].

Claim 1 recites “storing said custom content object in said one or more object servers; and storing information specifying the custom content object and attribute information concerning the custom content object in the library server.” The Examiner concedes that

McGraw-Hill does not disclose the claimed one or more object servers and a library server and cites Santamaki to cure the deficiency.

In particular, the Examiner asserts that Santamaki, col. 5, lines 6-16, discloses a centralized server for storing electronic written materials and an e-book server for storing selected electronic written materials that have been converted into an electronic book format for subsequent download to a terminal for viewing.

In Santamaki, electronic written materials are stored in the centralized server 12 and an e-book server 30 stores selected electronic written materials that have been converted into an electronic book format for individual users to download to an electronic book terminal 50. The e-book server 30 is an online electronic archive of electronic documents that have already been converted into an e-book format, encoded and stored so as to be displayed on an e-book terminal 50. See col. 12, lines 58-65. The electronic written materials can include text, documents, pictures and graphics. See col. 4, lines 56-60. However, there is no teaching or suggestion that such electronic materials include a custom content object (screen shot on page 9 of McGraw Hill as asserted by the Examiner) or attribute information (book ID as asserted by the Examiner).

Assuming *arguendo*, the centralized server and the e-book server of Santamaki teaches the claimed object servers and library server, the combination of Santamaki with McGraw-Hill is not obvious. In order to use the e-book server 30 of Santamaki, a user is required to download specialized software in order to view the electronic materials. See Santamaki col. 5, lines 37-50 (e.g. Add Printer Wizard). Consequently, modifying McGraw-Hill to require the downloading of specialized e-book server software would result in a substantial modification of the principle of

operation of McGraw Hill, evidencing that the Examiner's reasoning is merely a result of impermissible hindsight upon viewing the Applicant's invention. MPEP 2143.01.

For at least the above reasons, claim 1 and its dependent claims should be deemed allowable. To the extent claims 30, 31, 60, 61 and 90 recite similar elements, they should be deemed allowable for at least the same reasons.

III. Rejection of claims 2-3, 29, 32-33, 59, 62-63, and 89 have been rejected under 103(a) as being unpatentable over McGraw in view of Mortimer

Claims 2-3, 29, 32-33, 59, 62-63, and 89 have been rejected under 103(a) as being unpatentable over McGraw in view of Mortimer et al. [USP 6,091,930]. Claims 2-3, 29, 32-33, 59, 62-63, and 89 should be deemed allowable by virtue of their dependency to claim 1, 31 and 61 for the reasons set forth above. Moreover, Mortimer does not cure the deficiencies of McGraw and Santamaki.

IV. Rejection of claims 4-5, 34-35 and 64-65 have been rejected under 103(a) as being unpatentable over McGraw in view of ks Sinclair.com

Claims 4-5, 34-35 and 64-65 have been rejected under 103(a) as being unpatentable over McGraw in view of ks Sinclair.com [Free E-books You Can Download]. Claims 4-5, 34-35 and 64-65 should be deemed allowable by virtue of their dependency to 1, 31 and 61 for the reasons set forth above. Moreover, ks Sinclair.com does not cure the deficiencies of McGraw and Santamaki.

V. Rejection of claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 under 103(a) as being unpatentable over McGraw in view of Poole

Claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 have been rejected under 103(a) as being unpatentable over McGraw in view of Poole et al. [USP 6,006,242]. Claims 9-

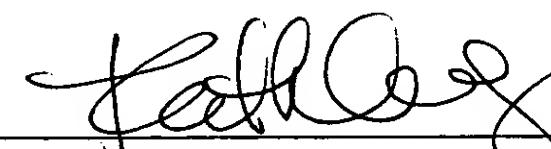
10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 should be deemed allowable by virtue of their dependency to claims 1, 31 and 61 for the reasons set forth above. Moreover, Poole does not cure the deficiencies of McGraw and Santamaki.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Ruthleen E. Uy
Registration No. 51,361

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: March 31, 2006